

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. APPLN. NO. 09/354,161
ATTORNEY DOCKET NO. Q55099

returned an initialed PTO-1449 form in the next Communication, thereby confirming that the listed references have been considered.

Claims 1-14 have been examined on their merits.

Applicant thanks the Patent Office for indicating that claims 4-6 are allowed.

The Patent Office objects to claims 12-14 as being dependent upon a rejected base claim.

Applicant thanks the Patent Office for indicating that claims 12-14 would be allowed if rewritten in independent form. However, instead of rewriting claims 12-14 in independent form, Applicant respectfully traverses the prior art rejections for the reasons set forth below.

Claims 1-14 are all the claims pending in the application.

1. Claims 1-3 and 7-11 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Apperson *et al.* (U.S. Patent No. 5,978,484). Applicant traverses the rejection of claims 1-3 and 7-11 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior

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art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Apperson *et al.* fail to teach or suggest a service provider forwarding a request to a certifying authority for authorization, wherein the request comprises a definition of at least part of a global functionality supported in a telecommunication environment, and further, including in the certificate a definition of the predefined functionality if the request is granted by the certifying authority, as recited in claim 1. The Patent Office asserts that hierarchical tree shown in Figure 3 of Apperson *et al.* somehow discloses a service provider making a functionality request to a certifying authority. However, Apperson *et al.* fail to teach or suggest sending a functionality request to a certifying authority, wherein the functionality request is examined, and, if granted, incorporated into the forwarded certificate. In Apperson *et al.*, all the privilege request codes are already incorporated into the certificates, and there does not appear to be any disclosure of examination of functionality requests from service providers. In contrast to the present invention, Apperson *et al.* disclose that the privilege request comes from the client (col. 9, line 50 to col. 10, line 12), and not the distributing authority.¹ Unlike the present invention, the distributing authority (*e.g.*, the service provider) does not make “functionality” requests to the certifying authority.

In addition, the Patent Office continues to allege that the “predefined functionality” and the “global functionality” recited in claim 1 is somehow equivalent to the software delivered by

¹ In the Final Office Action, the Examiner equates the service provider with the distributing authority. See May 20, 2004 Final Office Action, pg. 6.

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Apperson *et al.* However, even using the Patent Office's interpretation of "functionality", the "functionality" delivered by Apperson *et al.* already contains the digital certificate within the "functionality" before the distributing authority is certified. *See, e.g.,* Fig. 5, block 104. Moreover, the "functionality" delivered by Apperson *et al.* is never even sent to a certifying authority, but instead the certification is received after the "functionality" is delivered to the user terminal. *See* Fig. 5, block 116.

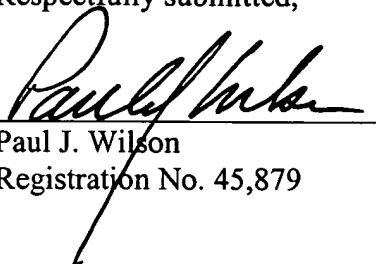
Based on the foregoing reasons, Applicant submits that Apperson *et al.* fail to disclose all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Apperson *et al.* clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicant submits that claim 1 is allowable, and further submits that claims 2, 3 and 7-11 are allowable as well, at least by virtue of their dependency from claim 1. Applicant respectfully requests that the Patent Office withdraw the § 102(e) rejection of claims 1-3 and 7-11.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Paul J. Wilson
Registration No. 45,879

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

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